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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,519	07/20/2001	Lee A. Hollaar	1169.1 P	1725

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EXAMINER

COBY, FRANTZ

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/909,519

Applicant(s)

HOLLAAR ET AL.

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

This is in response to Applicant's response filed on December 23, 2003 in which claims 19-20 were added.

Applicant's arguments with respect to claim 1-18 have been considered but are moot in view of the new ground(s) of rejection.

**Status of Claims**

Claims 1-20 are pending.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 19-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Krause U.S. Patent no. 5,526,520.

As per claim 1, Krause discloses, "a method operating on a digital computer system" by providing a method to organize and manipulate blueprint documents using hypermedia links from a primary documents to recall related secondary documents (See

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Krause Title). In particular, Krause disclose the claimed features of "displaying a reference document containing a quotation of a passage from a source document to permit the selection of the quotation by a user; retrieving the source document containing the passage quoted in the quotation selected by the user; locating the quoted passage in the source document, where the highlighting of the quoted passage is based on the result of the location step and not highlighting previously in the source document" (See Krause Col. 4, lines 15-65).

As per claim 2, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Krause discloses the claimed feature of "a digital computer programmed to perform the method of claim 1, (See Krause Figure 1 and corresponding text).

As per claim 3, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Krause discloses the claimed feature of "a computer readable medium storing a computer program implementing the method of claim 1" (See Krause Figure 1 and corresponding text).

As per claims 19-20, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Krause discloses the claimed feature of "wherein said quotation has been

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copied from said source document, or another document hat itself quoted said source document, when said reference document was created; where said copying was performed as said reference document was being written by retyping said quoted passage into said reference document or by selecting said quoted passage from said source document and then inserting said selected passage into said reference document using a word processor" by providing mechanism for copying (Krause Col. 6, lines 46-59).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 4-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krause U.S. Patent no. 5,526,520 in view of Rivette et al. U.S. Patent no. 5,845,301.

As per claim 4, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above.

It is noted, however, Krause did not specifically detail the claimed feature of "wherein the locating step utilizes an approximate matching technique to locate the quoted passage" as recited in the instant claim 4. On the other hand, Rivette et al. disclose a system and method for displaying and processing notes containing note segments linked to portions of documents including methodology for searching which allows an approximate matching technique (See Rivette et al. Col. 4, lines 21-25).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the file linking methodology of Krause by incorporating the searching mechanism of Rivette et al. because that would have enhanced the versatility of Krause linking methodology by allowing it to link documents more efficiently. Also because that would have allowed Krause to display text and image documents in both synchronized and unsynchronized fashion (See Rivette et al. Col. 3, lines 18-24).

As per claim 5, most of the limitations of these claims have been noted in the rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above. In addition, Krause discloses the claimed feature of "a digital computer programmed to perform the method of claim 1" (See Krause Figure 1 and corresponding text).

As per claim 6, most of the limitations of these claims have been noted in the rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above. In addition, Krause discloses the claimed feature of "a computer readable medium storing a computer program implementing the method of claim 1" (See Krause Figure 1; Col. 4, line 66-Col. 5, line 11).

As per claims 7-12, most of the limitations of these claims have been noted in the rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above. In addition, Krause achieves the claimed feature of "displaying a source document indicating any differences between the quotation and the quoted message" through a display mechanism (See Krause Figure 1, component 14).

As per claims 13-18, most of the limitations of this claim have been noted in the rejection of claims 1-6. Applicant's attention is directed to the rejection of claims 7-12 above. In addition Rivette et al. achieve the claimed feature of "using one highlighting mode to highlight portions of the quoted passage that are contained in the selected quotation, and using another highlighting mode to display portions of the quotation that are not in the quoted passage " (See Rivette et al. Col. 4, lines 10-17).


### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Monday - Friday from 10:30AM -10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Frantz Coby  
Primary Examiner  
Art Unit 2171

March 20, 2004